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09/187,332 11/06/98 NAYLOR

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EXAMINER

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| ART UNIT | PAPER NUMBER |
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2152

DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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|------------------------------|--------------------------------------|--------------------------------------|
| Office Action Summary | Application No. 09/187,332 | Applicant(s) Naylor et al. |
| | Examiner Robert Harrell | Art Unit 2152 |

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on Apr 16, 2001
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 835 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on 4/16/01 is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - a) All b) Some* c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 8
- 18) Interview Summary (PTO-413) Paper No(s). _____
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other: See attached.

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1. Claims 1-18 remain for examination.

2. The applicant's amendment to figure 4 is accepted.

However, figure 1 should be labeled as "Prior Art" in light of Ho et al. (5,805,298) (see figure 2 of Ho). The applicant argued that figure 1 need not be amended because Ho fails to show a "CPU and memory". However, col. 5 (lines 40-52) stated that controller 214 was an Intel 80486 (a CPU) connected to memory.

3. The applicant's arguments filed 4/16/01 (paper #10) has been considered but deemed moot in view of the following new rejection based on the primary argument that it would not have been obvious to send e-mail and facsimile at the same time. While the claims fail to indicated "at the same time", the following new rejection is set forth.

4. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this office action:

a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligations under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly

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owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102 (f) or (g) prior art under 35 U.S.C. 103.

6. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ho et al. (5,805,298) alone or in view of Fabbio et al. (5,870,089).

7. Ho taught the invention substantially as claimed, including a process for sending electronic mail or facsimiles (eg., see Abstract) from a facsimile machine (100 in figure 1 (eg., see figure 2, col. 3 (lines 27-32)) comprising the steps of:

- a) a user entering into the facsimile machine a facsimile telephone number (eg., see col. 6 (lines 31-35)) and an electronic mail address (eg., see col. 6 (lines 35-48)) corresponding to a same recipient;
- b) the user placing a document to be transmitted into a facsimile machine (eg., see figure 1 (101,204), col. 4 (lines 10-19));
- c) the fax machine storing the facsimile telephone number or electronic mail address in a memory location in a memory of the facsimile machine (eg., see col. 5 (line 40-et seq.));
- d) associating an actuator ("Send Button") disposed on the facsimile machine (eg., see figure 2(a)) to the memory location containing the facsimile telephone number and electronic mail address (eg., see figure 3 and col. 6 (line 23-et seq.)); and,

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e) the user activating the actuator to transmit a facsimile to the facsimile telephone number or electronic mail to the electronic mail address (eg., see col. 6 (lines 27-41) and col. 7 (lines 6-17)).

8. While Ho did not specifically send the message via both by facsimile and e-mail, such would have been obvious to those skilled in the art when taken Ho alone. That is, the message could first be sent by e-mail and then latter by facsimile or at the same time. Furthermore, on line 2 of Ho's abstract, in col. 1 (lines 46-53), and in col. 2 (lines 19-22) Ho suggested transmitting in both facsimile and electron mail. Since his device could do both, doing both at different times or at the same time would have been obvious to those skilled in the art. Also, sending the message by facsimile and e-mail would have been obvious to those skilled in the art when taking Ho in view of Fabbio who taught of sending electronic mail and facsimile (eg., see col. 3 (lines 4-23)) at the same time. Also, the claims of this application fails to teach at what moment (ie., at the same time) the electronic mail is transmitted with respect to the facsimile of the message (ie., a time lag is also covered by the claims).

9. It would have been obvious to have combined these references

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because they were both directed to sending electronic mail and facsimile to a recipient from a single device. Furthermore, col. 6 (lines 32-36) of Fabbio stated that the delivery service system 12 of figure 2 could be either a stand alone computer or a local area network (LAN) as called for by Ho in col. 3 (line 54) to col. 4 (line 6). Since Ho called for a LAN version, and Fabbio taught a LAN version, it would have been obvious to those skilled in the art to use Fabbio's system in Ho's system (specifically delivery server 12 of Fabbio's second figure for the PSTN 106 in Ho's first figure).

10. Per claim 2, Ho taught that his actuator was a button (eg., see figure 2(a)) and buttons are switches.

11. Per claims 3 and 4, Ho taught that electronic mail was sent via a server (SLIP/PPP (ie., an Internet Service Provider)) and facsimile was sent to the recipient via a PSTN 106 in figure 1 and col. 3 (lines 32-43). A PSTN is a Public Switch Telephone Network having several computers. Also, Fabbio taught that the delivery server 12 was a server.

12. Per claim 5, such is standard facsimile operations and was taught in Ho at col. 6 (line 27-*et seq.*).

13. Per claim 6, while the device (100) performed these functions (ie., if there is a phone number the message was faxed

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or if it were an e-mail address the message was sent via e-mail)

(eg., see Ho's col. 6 (lines 31-38) and col. 7 (lines 6-17)).

14. Per claim 7, while PSIN has been addressed, Ho taught of the use of the Internet (eg., see figure 1 (112)) which is a wide area network.

15. Per claims 8-18, these do not teach and define above the corresponding claims and are thus also rejected for the reasons outlined above.

16. In conclusion, Ho taught the invention as claimed except for send both the fax and e-mail "at the same time". But since Ho could either fax or e-mail one or the other, Ho had the means for sending them at the same time. Thus, in light of Fabbio, sending a fax and an e-mail at the same time in Ho would have been obvious to those skilled in the art.

17. This action is NOT FINAL.

18. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (703) 305-9692. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on (703) 305-4815. The fax phone number for the Group is (703) 308-7201.

21. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group

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receptionist whose telephone number is (703) 305-9600.



ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2152